

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	86058261
LAW OFFICE ASSIGNED	LAW OFFICE 101
MARK SECTION (no change)	
EVIDENCE SECTION	
EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	evi_9819121474-20141119141643390570_.Request_for_Reconsideration.pdf
CONVERTED PDF FILE(S) (4 pages)	\\TICRS\EXPORT16\IMAGEOUT16\860\582\86058261\xml13\RFR0002.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\860\582\86058261\xml13\RFR0003.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\860\582\86058261\xml13\RFR0004.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\860\582\86058261\xml13\RFR0005.JPG
DESCRIPTION OF EVIDENCE FILE	response
GOODS AND/OR SERVICES SECTION (current)	
INTERNATIONAL CLASS	025
DESCRIPTION	
Clothing, namely, jackets, anoraks, pullovers, trousers, t-shirts, kagouls in the nature of anoraks, smocks and salopettes, gloves, hats, balaclavas, socks, underwear and gaiters; sweatbands; beachwear; swimwear; sweatshirts; dresses and tracksuits; clothing accessories, namely, gloves, belts for clothing, scarves, mittens, hosiery, leggings, headgear, namely, hats and caps; footwear; belts being clothing, excluding clothing for aviation and scientific and technical apparel	
FILING BASIS	Section 1(b)
FILING BASIS	Section 44(e)
FOREIGN REGISTRATION NUMBER	1224399

FOREIGN REGISTRATION COUNTRY	United Kingdom
FOREIGN REGISTRATION DATE	08/09/1984
FOREIGN EXPIRATION DATE	08/09/2015
GOODS AND/OR SERVICES SECTION (proposed)	
INTERNATIONAL CLASS	025
TRACKED TEXT DESCRIPTION	
<p>Clothing, namely, jackets, anoraks, pullovers, trousers, t-shirts, kagouls in the nature of anoraks, smocks and salopettes, gloves, hats, balaclavas, socks, underwear and gaiters; sweatbands; beachwear; swimwear; sweatshirts; dresses and tracksuits; clothing accessories, namely, gloves, belts for clothing, scarves, mittens, hosiery, leggings, headgear, namely, hats and caps; footwear; belts being clothing, excluding clothing for aviation and scientific and technical apparel; <u>belts being clothing, all of the foregoing excluding clothing for aviation and scientific and technical apparel.</u></p>	
FINAL DESCRIPTION	
<p>Clothing, namely, jackets, anoraks, pullovers, trousers, t-shirts, kagouls in the nature of anoraks, smocks and salopettes, gloves, hats, balaclavas, socks, underwear and gaiters; sweatbands; beachwear; swimwear; sweatshirts; dresses and tracksuits; clothing accessories, namely, gloves, belts for clothing, scarves, mittens, hosiery, leggings, headgear, namely, hats and caps; footwear; belts being clothing, all of the foregoing excluding clothing for aviation and scientific and technical apparel.</p>	
FILING BASIS	Section 1(b)
FILING BASIS	Section 44(e)
FOREIGN REGISTRATION NUMBER	1224399
FOREIGN REGISTRATION COUNTRY	United Kingdom
FOREIGN REGISTRATION DATE	08/09/1984
FOREIGN EXPIRATION DATE	08/09/2015
SIGNATURE SECTION	
RESPONSE SIGNATURE	/Thomas W. Cole/
SIGNATORY'S NAME	Thomas W. Cole
SIGNATORY'S	

POSITION	Attorney
SIGNATORY'S PHONE NUMBER	703-677-3001
DATE SIGNED	11/19/2014
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	NO
FILING INFORMATION SECTION	
SUBMIT DATE	Wed Nov 19 15:03:44 EST 2014
TEAS STAMP	USPTO/RFR-98.191.214.74-2 0141119150344042490-86058 261-500cc1887fca94f6ed9c9 1d9ce07eaf7f76541ff141a6f 0c99672cc857ee69fcea-N/A- N/A-20141119141643390570

Request for Reconsideration after Final Action To the Commissioner for Trademarks:

Application serial no. **86058261** has been amended as follows:

EVIDENCE

Evidence in the nature of response has been attached.

Original PDF file:

[evi_9819121474-20141119141643390570_.Request_for_Reconsideration.pdf](#)

Converted PDF file(s) (4 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

CLASSIFICATION AND LISTING OF GOODS/SERVICES

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 025 for Clothing, namely, jackets, anoraks, pullovers, trousers, t-shirts, kagouls in the nature of anoraks, smocks and salopettes, gloves, hats, balaclavas, socks, underwear and gaiters; sweatbands; beachwear; swimwear; sweatshirts; dresses and tracksuits; clothing accessories, namely, gloves, belts for clothing, scarves, mittens, hosiery, leggings, headgear, namely, hats and caps; footwear;

belts being clothing, excluding clothing for aviation and scientific and technical apparel

Original Filing Basis:

Filing Basis: Section 1(b), Intent to Use: The applicant has had a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

Filing Basis: Section 44(e), Based on Foreign Registration: Applicant has a bona fide intention to use the mark in commerce on or in connection with the identified goods and /or services, and submits a copy of [United Kingdom registration number 1224399 registered 08/09/1984 with a renewal date of _____ and an expiration date of 08/09/2015], and translation thereof, if appropriate. 15 U.S.C. Section 1126(e), as amended.

Proposed:

Tracked Text Description: Clothing, namely, jackets, anoraks, pullovers, trousers, t-shirts, kagouls in the nature of anoraks, smocks and salopettes, gloves, hats, balaclavas, socks, underwear and gaiters; sweatbands; beachwear; swimwear; sweatshirts; dresses and tracksuits; clothing accessories, namely, gloves, belts for clothing, scarves, mittens, hosiery, leggings, headgear, namely, hats and caps; footwear; ~~belts being clothing, excluding clothing for aviation and scientific and technical apparel;~~ belts being clothing, all of the foregoing excluding clothing for aviation and scientific and technical apparel.

Class 025 for Clothing, namely, jackets, anoraks, pullovers, trousers, t-shirts, kagouls in the nature of anoraks, smocks and salopettes, gloves, hats, balaclavas, socks, underwear and gaiters; sweatbands; beachwear; swimwear; sweatshirts; dresses and tracksuits; clothing accessories, namely, gloves, belts for clothing, scarves, mittens, hosiery, leggings, headgear, namely, hats and caps; footwear; belts being clothing, all of the foregoing excluding clothing for aviation and scientific and technical apparel.

Filing Basis: Section 1(b), Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

Filing Basis: Section 44(e), Based on Foreign Registration: Applicant has a bona fide intention to use the mark in commerce on or in connection with the identified goods and /or services, and will submit a copy of [United Kingdom registration number 1224399 registered 08/09/1984 with a renewal date of _____ and an expiration date of 08/09/2015], and translation thereof, if appropriate, before the application may proceed to registration. 15 U.S.C. Section 1126(e), as amended.

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /Thomas W. Cole/ Date: 11/19/2014

Signatory's Name: Thomas W. Cole

Signatory's Position: Attorney

Signatory's Phone Number: 703-677-3001

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power

of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is not filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 86058261

Internet Transmission Date: Wed Nov 19 15:03:44 EST 2014

TEAS Stamp: USPTO/RFR-98.191.214.74-2014111915034404

2490-86058261-500cc1887fca94f6ed9c91d9ce

07eaf7f76541ff141a6f0c99672cc857ee69fcea

-N/A-N/A-20141119141643390570

Request for Reconsideration

Registration of the applied-for mark is refused, and the refusal is made final, because of a likelihood of confusion with the marks in U.S. Registration Nos. 4069556 and 4103144.

U.S. registration No. 4069556 AVIATOR CLOTHING COMPANY

Applicant appreciates the indication by the Examining Attorney that if the Applicant were to amend the identification to clarify that the limitation applied to all of the goods, that would overcome the Section 2(d) refusal based on the registration No. 4069556.

In response, Applicant amends its goods as suggested by the Examining Attorney as follows:

Clothing, namely, jackets, anoraks, pullovers, trousers, t-shirts, kagouls in the nature of anoraks, smocks and salopettes, gloves, hats, balaclavas, socks, underwear and gaiters; sweatbands; beachwear; swimwear; sweatshirts; dresses and tracksuits; clothing accessories, namely, gloves, belts for clothing, scarves, mittens, hosiery, leggings, headgear, namely, hats and caps; footwear; belts being clothing, **all of the foregoing** excluding clothing for aviation and scientific and technical apparel.

Hence, the likelihood of confusion refusal with respect to US registration 4069556 should now be withdrawn.



U.S. registration 4103144

With respect to the last cited registration 4103144 in the name of Societe Parisienne de Parfums



et Cosmetiques for , in part, clothing, namely, shirts, t-shirts, sweatshirts, hats, caps, jackets, coats and pants.

As the examining attorney sets forth, , numerous “aviator” marks are able to coexist because each mark has at least one additional term or element that would allow consumers to distinguish each mark from the other marks. In the Examining Attorney’s opinion the proposed mark AVIATOR, without any additional terms or design elements, would not be distinguishable from the other “aviator” marks.

Applicant respectfully disagrees and makes additional arguments for the Examining Attorney's review and consideration.

Marks must be viewed in their entirety. J. Thomas McCarthy, McCarthy on Unfair Competition and Trademarks at §23:41 citing the Anti-dissection rule. The anti-dissection rule finds its basis in the Supreme Court ruling on point which noted that "[t]he commercial impression of a trademark is derived from it as whole, not from its elements separated and considered in detail." Id. citing Estate of P.D. Beckwith, Inc., v. Commr' of Patents, 252 U.S. 538, 54-49 (1920). In this case the analysis must be conducted viewing the cited registration in its entirety as well as in view of the proper breadth and scope of protection afforded weak and diluted marks.

The cited registration consists of a large design with the double word portions in smaller



presentation. In this instance the logo is the most prominent and dominant portion of the mark. Applicant understands as a general rule word portions are considered dominant, but in this case the design overpowers the words which are within the design, unlike many logo marks divorced and separated from the word portions. Also, "[a] mark hemmed in on all sides by similar marks on similar goods cannot be very "distinctive." McCarthy on Trademarks at §11:85 citing Puma-Sportschufabriken Rudolf Dassler K.G. Superfa S.p.A, 210 ISPQ 316 (TTAB 1980)(plethora of similar marks limits protection to a narrow breadth). In a crowded field of similar marks, each member of the crowd is relatively "weak" in its ability to prevent use by



others in the crowd. Id. Here, the design portion of the registered mark is highly noticeable and distinguishes the mark from the mark AVIATOR standing alone.

Mark AVIATOR is weak and diluted

As the Examiner recognizes the mark AVIATOR is weak and diluted. The Examiner submits that for marks to coexist in cases where marks are diluted it requires additional matter for coexistence. The Examiner concludes that the mark AVIATOR standing alone cannot coexist with the cited registration because it lacks additional matter. Applicant respectfully disagrees.

Applicant submits that single word marks can be registered and do exist with word marks with additional matter for the same goods. Applicant notes the following cases.

Mark	Mark	Case
ALL	ALL CLEAR	Lever Bros. Co v. Barcolene Co., 463 F. 2d 1107, 174 U.SP.Q. 392 (C.C. P.A. 1972)
FLIP	FINAL FLIP	Bell Laboratories, Inc. v. Colonial Products, Inc., 644 F. Supp. 542, 231 U.S.P.Q. 569 (S.D. Fla. 1986)
PARENTS	PARENTS DIGEST	Gruner + Jahr USA Publishing v. Meredith Corp., 991 F. 2d 1072, 26 U.S.P.Q. 2d 1583 (2d Cir. 1993)
TIC TAC TOE	TIC TAC	In re Ferrero, 479 F.2d 1395, 178 U.S.P.Q. 167 (C.C.P.A. 1973)
TEEN	TEEN PEOPLE	Time, Inc. v Petersen Pub Co. L.L.C., 173 F.3d 113, 50 U.S.P.Q. 2d
ROMAN	ROMANBURGER	Mr. Hero Sandwich Systems Inc. v Roman Meal Co., 781 F.2d 884, 228 U.S.P.Q. 364 (Fed. Cir. 1986) both for food products

The Examiner's position that coexistence requires both marks to have additional matter is belied by the above examples. As indicated by the above cases, single word marks coexist with marks using the same word with additional matter, and vice versa. There is no difference which mark registered first. In this case the two marks are different, AVIATOR compared with the Prominent



circle design and Aviator repeated twice . Applicant respectfully acknowledges the Examiner's position but submits the issues presented herein warrant reconsideration by the Examiner and the refusal based on the US registration 4103144 be withdrawn.

It is therefore respectfully submitted that the present mark is unlikely to cause confusion with the cited registration, and it is believed that both of these marks can co-exist in the marketplace without confusion. Accordingly, it is respectfully requested that the §2(d) refusal to register the above-referenced mark be withdrawn.